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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,900	07/11/2000	IAN E. SMITH	XER1P006	9960

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OPPENHEIMER WOLFF & DONNELLY
P. O. BOX 10356
PALO ALTO, CA 94303

EXAMINER

LAFORGIA, CHRISTIAN A

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/613,900

Applicant(s)

SMITH ET AL.

Examiner

Christian La Forgia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 10, 24 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-23, 25-37 and 39-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 May 2004 has been entered.

2. Claims 1-45 have been presented for examination.

3. Claims 10, 24, and 38 have been cancelled as per Applicant's request.

Response to Arguments

4. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there is knowledge generally available to those of ordinary skill in the art. As such, further information regarding e-mail aliasing can be found in U.S. Patent Nos. 6,604,079; 6,775,689; 6,721,785; 6,643,685; 5,704,017.

5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., generating summaries of messages, folder contents or attributes and storing those summaries) are not recited

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in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

6. Applicant's arguments with respect to claims 1-9, 11-23, 25-37, and 39-45 have been considered but are moot in view of the new ground(s) of rejection.

7. See further rejections that follow.

Specification

8. The use of the trademark Java has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

9. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 103

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1-9, 11-23, 25-37, and 39-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,442,546 to Biliris et al., hereinafter Biliris, in view of U.S. Patent No. 6,775,689 to Raghunandan, hereinafter Raghunandan.

12. As per claims 1, 15, and 29, Biliris teaches a computerized method of providing a service comprising the steps of storing a portion of the e-mail message in a database in at least figures 1, blocks 108a, 108z, 8, and column 5, line 46 to column 6, line 3. Biliris further teaches invoking

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at least one application to provide the service responsive to the content of the e-mail received by the e-mail invoked application server in column 1, lines 54-60 wherein he states:

An application selection device is operable to examine at least some of the messaging entities and at least some of the attributes and to select an application to be invoked, from among the plurality of applications based on the values of the examined messaging entities and attributes. An application invocation device invokes the selected application.

The application selection device and application invocation device are shown in figure 11 and discussed in column 7. Biliris discloses the claimed invention except for e-mail aliasing.

13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include e-mail aliasing, since Raghunandan states at column 2, lines 1-9 that such a modification would facilitate identification and reduce the burden of repeatedly entering individual e-mail addresses.

14. Regarding claims 2, 16, and 30, Biliris teaches wherein information coupled with the e-mail message is stored in the database in at least figures 6, block 408, 8, and 9, as well as column 3, line 43 to column 4, line 10 and column 4, lines 20-38.

15. Regarding claims 3, 17, and 31, Biliris teaches wherein the at least one application is selected from the group consisting of a lead tracking application, a job requisitioning application, an even planning application, a task list management application, a project management application, and an accountability application in figure 11, in addition to column 7, lines 1-38.

16. Regarding claims 4, 18, and 32, Biliris does not teach wherein a reply to the e-mail is utilized to advance the processing of a task. It would have been obvious to one of ordinary skill

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in the art at the time the invention was made to provide a reply to an e-mail so as to advance the processing of a task. Since it has been held in *Biliris* that e-mails can be used to invoke applications, replying to an e-mail that spawned said task would help to advance that task if it ever became dormant or stalled.

17. Regarding claims 5, 19, and 33, *Biliris* teaches wherein the at least one application summarizes an interaction between one or more users of the e-mail invoked application server in figure 11, blocks 608 and 612, and column 7, lines 31-37.

18. With regards to claims 6, 20, and 34, *Biliris* teaches wherein a task list is generated to summarize the interaction in figure 11, blocks 608 and 612, and column 7, lines 31-37.

19. Regarding claims 7, 21, and 35, *Biliris* does not teach wherein an event is utilized to organize information from the database. It would have been obvious to one of ordinary skill in the art wherein an event is utilized to organize information from the database, since it has been held that changing an aesthetic feature, such as organizing information, requires only routine skill in the art. See MPEP § 2144.04; see also *In re Seid*, 161 F.2d 229, 231, 73 USPQ 431, 433 (CCPA 1947).

20. Regarding claims 8, 22, and 36, *Biliris* does not teach wherein an event is utilized to advance the processing of a task. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide for an event to advance the processing of a task.

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Since it has been held in Biliris that events can be used to invoke applications, providing for an event would help to advance a task if it ever became dormant or stalled.

21. Regarding claims 9, 23, and 37, Biliris does not teach wherein a reply to the e-mail message is utilized to generate another e-mail message to obtain information for the database. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a reply to an e-mail to obtain information for the database. Since it has been held in Biliris that e-mails can be used to obtain information, replying to an e-mail that spawned an application that has become quiet or dormant would aid in keeping apprised of the status of the application.

22. With regards to claims 11, 25, and 39, Biliris does not teach wherein the e-mail message includes an attachment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have an e-mail include an attachment. Since it has been held in the art that e-mail attachments are common and convenient for transmitting data, it would have only required routine skill in the art to include an attachment to an e-mail.

23. Regarding claims 12, 26, and 40, Biliris teaches wherein the e-mail message has one or more attributes, and further comprising steps of generating an index based on the one or more attributes of the e-mail message and storing the index in the database in column 6, lines 41-62.

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24. Regarding claims 13, 27, and 41, Biliris teaches further comprising categorizing the content into one or more categories, and permitting retrieval of the information from the database according to at least one of the one or more categories in column 6, lines 7-29.

25. Regarding claims 14, 28, and 42, Biliris teaches further comprising steps of analyzing information in the database; generating one or more summaries of the information responsive to the step of analyzing; storing the one or more summaries in the database; and permitting retrieval of at least one of the summaries from the database utilizing the network. It would have been obvious to one of ordinary skill in the art at the time the invention was made to summarize the entries of the database and return the summaries to clients. Since it has been held in Biliris that the attributes stored would be fairly simple yet quite numerous, there exists a need to simplify user access to the contents and it would have only required routine skill in the art to summarize the database and permit access to the summaries.

26. Concerning claims 43, 44, and 45, Biliris does not teach wherein the step of invoking at least one application is responsive to the attachment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to invoke an application in response to an e-mail attachment. Since it has been held in Biliris that an application is invoked in response to analyzing the contents and attributes of an e-mail, it would have only required routine skill in the art to invoke an application in response to detecting an attachment.

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

28. The following patents are cited to further show the state of the art with respect to e-mail aliasing, such as:

United States Patent No. 6,604,079 to Ruvolo et al., which is cited to show a system for feeding information to an e-mail system.

United States Patent No. 6,721,785 to Raghunandan, which is cited to show directing e-mail to selected recipients by applying transmission control directives on aliases identifying lists of recipients.

United States Patent No. 6,643,685 to Millard, which is cited to show creating unique user aliases for users in a communication network.

United States Patent No. 5,704,017 to Heckerman et al., which is cited to show collaborative filtering utilizing a belief network.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian La Forgia whose telephone number is (703) 305-7704. The examiner can normally be reached on Monday thru Thursday 7-5.

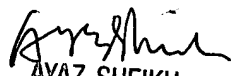
30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (703) 305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christian LaForgia
Patent Examiner
Art Unit 2131

clf


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100